

10008032-1

09/976,078

REMARKS

This is a full and timely response to the final Official Action mailed November 30, 2005 and the Advisory Action mailed on February 21, 2006. A one-month extension of time to respond to the final Office Action is hereby request and authorization to charge the requisite fee is also given. Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

Request for Continued Examination:

Applicant hereby requests Continued Examination for this application and entry and consideration of this amendment consequent thereto.

Claim Status:

Claims 18-20 have been cancelled previously. Thus, claims 1-17 and 21-23 are currently pending for further action.

Allowed Claims:

In the Advisory Action of February 21, 2006, the Examiner indicated the allowance of claims 1-7, 15-17, 21 and 23. Applicant wishes to thank the Examiner for the allowance of these claims.

Applicant agrees with the Examiner's conclusions regarding patentability, without necessarily agreeing with or acquiescing in the Examiner's reasoning. In particular, Applicant believes that the application is allowable because the prior art fails to teach, anticipate or render obvious the invention as claimed, independent of how the claims are paraphrased.

10008032-1

09/976,078

Prior Art:

The rejections of claims 8-14 and 22 were maintained in the Advisory Action of February 21, 2006. In the final Office Action of November 30, 2005, claims 8 and 12-14 were rejected as being unpatentable under 35 U.S.C. § 103(a) in view of the combined teachings of U.S. Patent Application Publication No. 2002/0188435 to Labarge ("Labarge") and U.S. Patent No. 5,175,684 to Chong ("Chong"). Claim 9 was rejected as being unpatentable under 35 U.S.C. § 103(a) over the combined teachings of Labarge, Chong and U.S. Patent No. 6,639,687 to Neilsen ("Neilsen"). For at least the following reasons, these rejections are respectfully traversed.

Claim 8 recites:

A method of executing a print job of an electronic document, said print job containing translations in a plurality of languages of said document, the method comprising:
submitting said print job to a printing device,
when said print job is submitted to said printing device, prompting a user through a graphical user interface to provide user input selecting one or more languages for translation of said document, and
automatically translating said electronic document into one or more languages according to said user input with an electronic translation program such that said resulting print job contains hardcopies of said document in a plurality of languages.
(emphasis added).

In contrast, the document translation method taught by Labarge and Chong does not occur "when said print job is submitted to said printing device," as claimed.

Labarge teaches a word processing application (210) that includes a translation tool (200). "At step 430, the list of translation services 208 are retrieved to the word processing application 210 and are populated into the drop-down menu 220, illustrated in FIG. 3. At step 435, the user locates the 'Japanese to English' command 209 and highlights the command. The user then selects the 'GO' button 232 to initiate translation of the selected document." (Labarge, paragraph 0075). When a translation is requested in this manner, the word

10008032-1

09/976,078

processor (210) sends the document to an Internet browser (240). “[T]he Internet browser 240 performs an HTTP POST request to the translation server URL provided to the word processing application by the redirector server 235.” (Labarge, paragraph 0079). “After the translated text is displayed by the user’s Internet browser 240, the method ends at step 490.” (Labarge, paragraph 0081). Thus, the translation is effected *without a print job being submitted to a printing device*. Consequently, this method taught by Labarge has nothing to do with prompting a user “when a print job is submitted to said printing device” to provide user input selecting one or more languages for translation of the document.

Moreover, Labarge does not teach or suggest “*prompting* a user ... to provide user input selecting one or more languages for translation of said document.” (emphasis added). Rather, the user selects a translation function from a drop down menu (220) *without* being prompted.

Consequently, Labarge fails to teach or suggest both the claimed prompting of a user and the timing of the prompting, i.e., when a print job is submitted to a printing device.

Chong likewise fails to teach or suggest this subject matter. The Chong system is designed primarily to allow a user to submit by fax or scanner a document in an original language. (Chong, abstract). The submitted document contains a written cover sheet in a particular format (See, Fig. 2) that is understood by the system as an instruction to translate the incoming document into another, target language. (Chong, col. 4, lines 64-68). The translation then occurs *without a print job being submitted to a printing device*.

Moreover, the user is not *prompted* to enter input selecting one or more languages for translation of the document. Rather, the language selections are written or marked on the paper cover sheet that is faxed or scanned into the system. (Chong, Fig. 2, “Language Selection Boxes”).

10008032-1

09/978,078

Thus, Chong, like Labarge, fails to teach or suggest prompting a user to provide user input selecting one or more languages for translation of said document and performing the prompting "when said print job is submitted to said printing device." Consequently, the references taken singly or together fail to teach or suggest all the features of the method of claim 8.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). For at least these reasons, the rejection of claim 8 and its dependent claims should be reconsidered and withdrawn.

Claims 10, 11 and 22 were rejected as being unpatentable under 35 U.S.C. § 103(a) over the combined teachings of Labarge, Chong, Neilsen and U.S. Patent No. 6,592,275 to Aihara ("Aihara").

Claim 10 recites:

The method of claim 8, wherein said printer comprises a plurality of output receptacles and said method further comprises allowing a user to specify a number of hardcopies in each of one or more languages to be output to each specific output receptacle, such that each output receptacle receives the specified number of hardcopies wherein said hardcopies in any one receptacle may comprises copies in different languages.

In contrast, the cited prior art does not teach or suggest a method in which the user can specify a number of hardcopies to be output to each specific output receptacle of a plurality of such receptacles where "hardcopies in any one receptacle may comprises copies in different languages."

10008032-1

09/976,078

The Office Action points out that Aihara teaches "associating a [specific] user with an output bin." (Action of 11/30/05, p. 12). However, associating a specific user with an output bin is not the same as allowing a user to specify to which output receptacle a particular number of hardcopies will go. Moreover, no prior art reference teaches or suggests that the user may specify that "hardcopies in any one receptacle may comprises copies in different languages" as claimed.

Thus, the cited combination of prior art fails to teach or suggest all the features of claim 10. "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). For at least these reasons, the rejection of claims 10, 11 and 22 should be reconsidered and withdrawn.

10008032-1


09/976,078

Conclusion:

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

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Steven L. Nichols
Registration No. 40,326

Steven L. Nichols, Esq.
Managing Partner, Utah Office
Rader Fishman & Grauer PLLC
River Park Corporate Center One
10653 S. River Front Parkway, Suite 150
South Jordan, Utah 84095

(801) 572-8066
(801) 572-7666 (fax)

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Rebecca R. Schow